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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,778	10/31/2001	David L. Henty	DLH1.PAU.02	8707
7590		04/21/2004		
David L. Henty Suite 1150 19900 MacArthur Blvd. Irvine, CA 92612				
EXAMINER KUMAR, SRILAKSHMI K				
ART UNIT		PAPER NUMBER		
2675		6		

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/003,778

Applicant(s)

HENTY, DAVID L.

Examiner

Srilakshmi K. Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al (US 6,445,379) in view of Gershenfeld et al (US 6,025,725).

As to independent claims 1, 8 and 9, Liu et al disclose a wireless mouse and reader combination (Fig. 1), comprising; a source of an interrogating field (Fig. 1, item 12); a wireless mouse having a movable XY encoder (Fig. 1, item 20), a plurality of mouse control buttons (Fig. 1, on the top of the upper housing, 21, there are a plurality of buttons), at least one antenna (col. 2, lines 32-37), and one or more transponder circuits coupled to the at least one antenna and associated with XY encoder and plurality of mouse control buttons and providing a response to the interrogating field identifying XY encoder motion and mouse control button activation; and a reader including a decoder for determining the response from the passive transponder circuits (col. 2, lines 24-54). Liu et al does not disclose where the transponder circuits are passive transponder circuits. Gershenfeld et al disclose a system for remotely sensing including coils made with magnetic materials as is disclosed in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art to combine Liu and Gershenfeld as the system of Gershenfeld would be typical of the transponders used. Further, Gershenfeld disclose in col. 3, lines 25-31, where this system would be used in a wireless computer input device.

As to dependent claim 2, limitations of claim 1, and further comprising, wherein said XY encoder comprises a ball (Fig. 1, item 23) adapted to rotate in response to mouse motion and X and Y encoder wheels coupled to the ball so as to respectively rotate in response to mouse motion in perpendicular directions (Fig. 1, on either side of where the ball is housed).

As to dependent claims 3 and 10, limitations of claims 2 and 9, and further comprising, wherein said XY encoder wheels further comprise a circuit element coupled to said one or more passive transponder circuits so as to tune and detune said one or more passive transponder circuits in response to mouse motion in X and Y directions (col. 2, lines 55-57).

As to dependent claim 4, limitations of claim 3, and further comprising, wherein said circuit element comprises a circuit element magnetically coupled to said one or more passive transponder circuits. Liu et al does not disclose where the transponder circuits are passive transponder circuits. Gershenfeld et al disclose a system for remotely sensing including coils made with magnetic materials as is disclosed in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art to combine Liu and Gershenfeld as the system of Gershenfeld would be typical of the transponders used. Further, Gershenfeld disclose in col. 3, lines 25-31, where this system would be used in a wireless computer input device.

As to dependent claim 5, limitations of claim 3, and further comprising, wherein said circuit element comprises a circuit element capacitively coupled to said one or more passive transponder circuits. Liu et al does not disclose where the transponder circuits are passive transponder circuits. Gershenfeld et al disclose a system for remotely sensing including coils made with magnetic and capacitative material as is disclosed in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art to combine Liu and Gershenfeld as the

system of Gershenfeld would be typical of the transponders used. Further, Gershenfeld disclose in col. 3, lines 25-31, where this system would be used in a wireless computer input device.

As to dependent claims 6 and 11, limitations of claims 1 and 9, and further comprising, wherein said interrogating field includes first and second frequencies and wherein said one or more passive transponder circuits resonant at said first and second frequencies, respectively (col. 4, lines 25-47).

As to dependent claims 7 and 12, limitations of claims 6 and 9, and further comprising, wherein said at least one antenna comprises first and second antennas respectively coupled to said first and second passive transponder circuits (col. 4, lines 25-47).

### ***Response to Arguments***

3. Applicant's arguments filed December 8, 2004 have been fully considered but they are not persuasive.

Applicant argues there is no reason to combine Liu with Gershenfeld. Examiner disagrees. The prior art, Gershenfeld et al disclose in col. 1, where the transponder relates to remotely sensing and monitoring various conditions to which objects are subject in particular using planar electromagnetic resonator packages. In col. 2, lines 60-67, Gershenfeld, two or more resonators are used on the same structure to monitor various conditions in the same environment. Further, Gershenfeld discloses in col. 3, lines 1-10, where resonators can be used to monitor physically in semiconductor chips or other electronic components. In still another aspect, differently characterized resonators are used to encode binary information. The invention may be used in a variety of practical applications including use as a wireless computer input device. Gershenfeld et al disclose a system for remotely sensing including coils made with

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magnetic materials as is disclosed in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art to combine Liu and Gershenfeld as the system of Gershenfeld would be typical of the transponders used.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srilakshmi K. Kumar whose telephone number is 703 306 5575. The examiner can normally be reached on 8:00 am to 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven J. Saras can be reached on 703 305 9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Srilakshmi K. Kumar  
Examiner  
Art Unit 2675

SKK  
April 17, 2004



DENNIS-DOON CHOW  
PRIMARY EXAMINER